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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,248

11/25/2003

Yves P. Arramon

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EXAMINER

DUFOUR, DEVANIE A

ART UNIT

PAPER NUMBER

3733

NOTIFICATION DATE

DELIVERY MODE

09/03/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel_prop@arthrocare.com

Office Action Summary	Application No. 10/723,248	Applicant(s) ARRAMON, YVES P.	
	Examiner DEVANIE DUFOUR	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>05/26/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 26, 32, 33 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Chan (US Pat. 5,788,463).

Chan discloses an implant material injection system adapted for performing a percutaneous vertebroplasty procedure comprising: a remote actuator (Fig. 1, ref. 60); a pump (Fig. 1, ref. 40) comprising a piston (Fig. 1, unmarked piston inside container 20) and a drive chamber (Fig. 1, ref. 20), the pump having a distal end (Fig. 1) adapted to connect with a cannula, the drive chamber adapted to hold implant material (Fig. 1), the piston adapted to drive the implant material through the distal end of the drive chamber to an implant site (Fig. 1) (column 11, lines 29-54); a control line (Fig. 1, ref. 45) connecting the remote actuator and the pump, the control line adapted to advance the piston (Fig. 1, the control line 45 is capable of advancing the piston inside the container 20 if one so desires); and wherein the implant material comprises a flowable hard tissue implant material (Fig. 2).

The control line comprises a fluid column adapted to advance the piston (column 11, lines 49-54). The system further comprising a cannula (Fig. 13, e.g. ref. 85) removably connected with the distal end of the drive chamber (Fig. 13-16). The system of further comprising an implant material reservoir connected with the pump (Fig. 1, ref. 30), the pump

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adapted to draw implant material from the material reservoir into the drive chamber (column 11, lines 29-54). The implant material comprises polymethylmethacrylate (Fig. 2)(column 11, lines 49-54). Specifically, the device is capable of moving fluids (Fig. 2)(column 11, lines 49-54) which would include a flowable hard tissue implant material (e.g. polymethylmethacrylate).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (US Pat. 5,788,463).

Chan discloses the claimed invention except for the control line has a length of about one foot. The control line has a length of about 36 inches. The control line has a length of at least 36 inches. The control line has a length of about 48 inches. The control line has a length greater than 48 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the control line at the above lengths, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive.

Applicant argues that Chan does not disclose the control line connects the remote actuator and the pump. The Examiner respectfully disagrees with applicant's arguments because Chan discloses a control line (45) connecting the remote actuator (Fig. 1, ref. 60) and the pump (Fig. 1, ref. 40).

Applicant argues that Chan does not disclose the control line is adapted to advance the piston of the pump. The Examiner respectfully disagrees with applicant's arguments because Chan discloses the control line (45) which is capable of advancing the piston (Fig. 1, piston within pump 40) of the pump (40). A control line is merely a tube that can convey pressurized air or fluid. Therefore, the control line is capable of advancing a piston within the container 20 by conveying fluid. The applicant refers to the pump as ref. 10 and the piston as ref. 55. However, the previous office action set forth that the pump is ref. 40. The pump comprises a piston as shown in Fig. 1 and a drive chamber ref. 20.

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the device of Chan, which is capable of being used as claimed if one so desires to do so. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458,459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is

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intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See form 892.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEVANIE DUFOUR whose telephone number is (571)270-7843. The examiner can normally be reached on Mon-Thurs 7:00 a.m.-5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./

Examiner, Art Unit 3733

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733